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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/572,525	10/26/2007	Xuejun Kang	007989.P002	4632

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EXAMINER

NGUYEN, KHIEM D

ART UNIT	PAPER NUMBER
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2823

MAIL DATE	DELIVERY MODE
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04/26/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/572,525	Applicant(s) KANG ET AL.	
	Examiner KHIEM D. NGUYEN	Art Unit 2823	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 29-31, 33, 35-38, 40-43, 45, 46 and 49-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 9, 11-13, 15, 18, 19, 21, 23-26 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/11/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 1-3,5,9,11-13,15,18,19,21,23-26,28-31,33,35-38,40-43,45,46 and 49-52.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on February 11th, 2010 has been entered.
2. By this amendment, claims 1, 3, 5, 15, 18, and 26 have been amended. Accordingly, claims 1-3,5,9,11-13,15,18,19,21,23-26, 28-31,33,35-38,40-43, 45-46, and 49-52 are pending in this application in which claims 29-31, 33, 35-38, 40-43, 45, 46 and 49-52 have been withdrawn from further consideration as being drawn to non-elected invention.
3. The newly submitted IDS filed on February 11th, 2010 has been considered. Please find enclosed the acknowledged copy of the 1449-form.
4. The amendment to the specification filed on February 11th, 2010 has been considered and has been entered.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the first ohmic contact layer comprising multiple meta layers and being a mirror at a junction between the first surface of the multiple epitaxial layers and the first ohmic contact layer". It is unclear how the first ohmic contact layer being both multiple metal layers and a mirror at the same time so that a mirror is at a junction between multiple epitaxial layers and the first ohmic contact layer. Does it mean the first ohmic contact layer comprising multiple metal layers and a mirror at a junction? In light of the aforementioned rejections of the claim(s) under 35 U.S.C. 112, second paragraph, the subsequent rejections under 35 U.S.C. 102 and/or 103 are based on prior art that reads on the interpretation of the claim language of the instant application as best understood by the Examiner.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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8. Claims 1-3, 9, 11-13, 15, 18, 19, 21, 23-26, and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Chien et al. (U.S. Patent 6,492,661).

In re claim 1, **Chien et al.** disclose a method for fabrication of a semiconductor device, the method including:

providing a wafer comprising a substrate **120** with multiple epitaxial layers **121**, **122** mounted on a substrate **120**, the multiple epitaxial layers **121**, **122** comprising an active region where light is able to be generated (see col. 5, lines 36-47 and FIG. 6a);

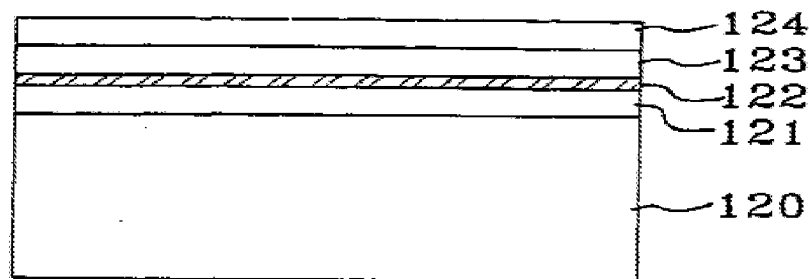


FIG. 6a

forming a first ohmic contact layer **124** on a first surface of the multiple epitaxial layers **121**, **122**, the first surface being remote from the substrate **120**, the first ohmic contact layer **124** comprising multiple metal layers and being a mirror **125** at a junction between the first surface of the multiple epitaxial layers **121**, **122** and the first ohmic contact layer **124** (see col. 5, lines 42-56 and FIG. 6c);

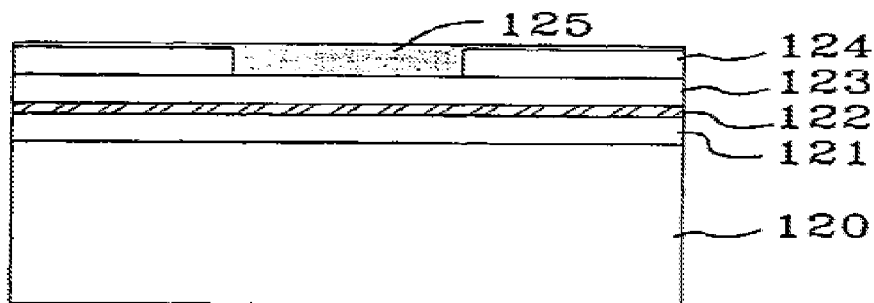


FIG. 6c

forming a relatively thick layer of a thermally conductive metal **126** adjacent to the first ohmic contact layer **124**, the thermally conductive metal **126** being of sufficient thickness to provide a heat sink (see col. 5, lines 51-56 and FIG. 6d); and removing the substrate **120** (see col. 5, line 54 and FIG. 6d).

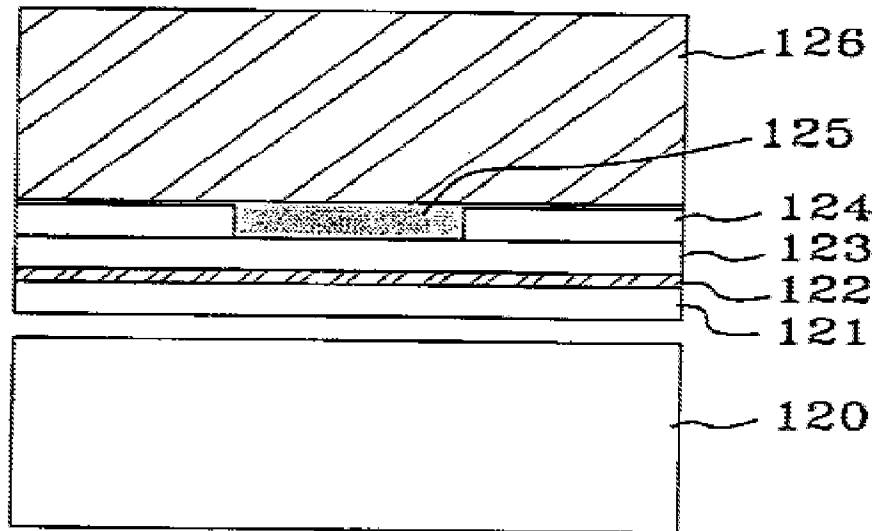


FIG. 6d

In re claim 2, as applied to claim 1 above, Chien et al. disclose all claimed limitations including the limitation wherein the first ohmic contact layer **124** is

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coated with an adhesion layer prior to application of a seed layer of thermally conductive metal, and wherein the relatively thick layer **126** is formed on the seed layer by electroplating (see col. 5, lines 36-67).

In re claim 3, as applied to claim 2 above, **Chien et al.** disclose all claimed limitations including the limitation wherein the seed layer is patterned with photoresist patterns before the electroplating, and the electroplating of the relatively thick layer **126** is between the photoresist patterns (see col. 5, lines 36-67).

In re claim 9, as applied to claim 2 above, **Chien et al.** disclose all claimed limitations including the limitation wherein the seed layer is electroplated without patterning, patterning being performed subsequently by photoresist patterning and then wet etching (see col. 5, lines 36-67).

In re claim 11, as applied to claim 9 above, **Chien et al.** disclose all claimed limitations including the limitation wherein patterning is by laser beam micro-machining of the relatively thick layer **126** (see col. 5, lines 36-67).

In re claim 12, as applied to claim 3 above, **Chien et al.** disclose all claimed limitations including the limitation wherein the relatively thick layer **126** is of a height no greater than the photoresist height (see col. 5, lines 36-67).

In re claim 13, as applied to claim 3 above, **Chien et al.** disclose all claimed limitations including the limitation wherein the relatively thick layer of thermally conductive metal **126** is electroplated to a height greater than the

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photoresist and is subsequently thinned, thinning being by polishing or wet etching (see col. 5, lines 36-67).

In re claim 15, as applied to claim 1 above, **Chien et al.** disclose all claimed limitations including the limitation wherein after the removing of the substrate 120, the method further comprises forming on a second surface (bottom surface) of the multiple epitaxial layers **121, 122** a second ohmic contact layer, the second ohmic contact layer being selected from the group consisting of: opaque, transparent, and semi-transparent, the second ohmic contact layer being one of blank and patterned, bonding pads being formed on the second ohmic contact layer (see col. 5, lines 54-56 and FIG. 6e).

In re claim 18, as applied to claim 1 above, **Chien et al.** disclose all claimed limitations including the limitation wherein after the removing of the substrate 120, the method further comprises forming an ohmic contact and subsequent processing, the subsequent processing including deposition of wire bond pads (see col. 5, lines 54-56 and FIG. 6e).

In re claim 19, as applied to claim 15 above, **Chien et al.** disclose all claimed limitations including the limitation wherein the second surface is cleaned and etched before the second ohmic contact layer is deposited, the second ohmic contact layer not covering the whole area of the second surface (see FIG. 6e).

In re claim 21, as applied to claim 15 above, **Hien et al.** disclose all claimed limitations including the limitation wherein a plurality of semiconductor

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devices are fabricated on the wafer, and wherein after forming the second ohmic contact layer there is included testing of the semiconductor devices on the wafer and separating the layers into individual devices (see col. 5, lines 36-67).

In re claim 23, as applied to claim 1 above, Hien et al. disclose all claimed limitations including the limitation wherein a plurality of semiconductor devices are fabricated on the wafer without one or more selected from the group consisting of: lapping, polishing and dicing (see col. 5, lines 36-67).

In re claim 24, as applied to claim 1 above, Hien et al. disclose all claimed limitations including the limitation wherein the first ohmic contact layer **124** is on p-type layers of the multiple epitaxial layers **121**, **122** (see col. 5, lines 36-56).

In re claim 25, as applied to claim 24 above, Hien et al. disclose all claimed limitations including the limitation wherein the second ohmic contact layer is formed on n-type layers of the multiple expitaxial layers **121**, **122** (see col. 5, lines 54-56).

In re claim 26, as applied to claim 1 above, Hien et al. disclose all claimed limitations including the limitation wherein after the removing of the substrate 120, the method further comprising, depositing dielectric films on the multiple epitaxial layers **121**, **122** ;and cutting openings in the dielectric films, the second ohmic contact layer, and the bond pads deposited on the multiple epitaxial layers (see col. 5, lines 36-56).

In re claim 28, as applied to claim 1 above, **Hien et al.** disclose all claimed limitations including the limitation wherein the thermally conductive metal **126** comprises copper and the multiple epitaxial layers **121**, **122** comprise multiple GaN-related layers (see col. 5, lines 36-56).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chien et al. (U.S. Patent 6,492,661).

In re claim 5, as applied to claim 3 paragraph 8 above, **Chien et al.** discloses wherein between the forming of the first ohmic contact layer **124** and the forming a relatively thick layer **126** of a thermally conductive metal, the method further comprises annealing the layers to improve adhesion, and wherein the photoresist patterns are of a predetermined height, a predetermined thickness range, and a predetermined spacing range (see col. 5, lines 36-56) but do not specifically disclose wherein the photoresist patterns are of a height in the range 15 to 500 micrometers, a thickness in the range 3 to 500 micrometers, and a spacing in the range of 200 to 2,000 microns.

However, there is no evidence indicating the height, thickness, and spacing of the photoresist patterns is critical and it has been held that it is not

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inventive to discover the optimum or workable range of a result-effective variable within given prior art conditions by routine experimentation. See MPEP § 2144.05. Note that the specification contains no disclosure of either the critical nature of the claimed dimensions of any unexpected results arising there from. Where patentability is aid to be based upon particular chosen dimensions or upon another variable recited in a claim, the Applicant must show that the chosen dimensions are critical. In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

Response to Applicants' Amendment and Arguments

11. Applicants' arguments with respect to claims 1-3, 5, 9, 11-13, 15, 18, 19, 21, 23-26 and 28 have been considered but are moot in view of the new ground(s) of rejection necessitated by the amendment filed on April 22nd, 2010.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KHIEM D. NGUYEN whose telephone number is (571)272-1865. The examiner can normally be reached on Monday-Friday (9:00 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Smith can be reached on (571) 272-1907. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Khiem D. Nguyen/
Primary Examiner, Art Unit 2823
April 22nd, 2010